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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,967

09/25/2003

Jeffrey O. Saunders

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ROPES & GRAY LLP
PATENT DOCKETING 39/361
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EXAMINER

KUMAR, SHAIENDRA

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,967	Applicant(s) SAUNDERS ET AL.	
	Examiner SHAIENDRA -. KUMAR	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-44 is/are pending in the application.
- 4a) Of the above claim(s) 21-40, 43 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-20 and 41-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/12/08 has been entered.

Claims 19-42 and newly added claims 43-44 are pending in this application. Claims 21-35 and 37-40 are withdrawn from the consideration, being drawn to the non elected subject matter. Claim 36 was inadvertently included in the previous office action as readable on the elected subject matter. Upon subsequent reconsideration, claims 36 is hereby withdrawn, as X is NR—CO-Y in the claim as against X being NR6CO in the elected subject matter. The error is regretted. Additionally, claims 43-44 are withdrawn from the consideration, being non readable on the elected species. Note R6 is H in the elected species as against, other than H in claims 43-44. Thus claims 19-20, and 41-42 are under consideration.

Rejection of claims 19-20 and 41-42 over Amschler et al is hereby withdrawn, subsequent to applicants' amendments and arguments.

Claim Rejections - 35 USC § 103

2. Claims 19-20 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino et al(US 6,071,968).

Nishino et al, various compounds in columns 11-13, and also column 3, teach compounds and pharmaceutical composition containing the structurally similar compounds as claimed in herein. Note that X can be NHCO, R1 to R5 can be alkyl, OH, and R7 to R11 can be H and amino, thus reading on the claimed composition.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the reference, because they are structurally so similar to those claimed in herein, with the reasonable expectation of achieving a successful composition for treating neurological disorders, absent evidence to the contrary.

Double Patenting

3. Claims 19-20 and 40-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,653,309. Although the conflicting claims are not identical, they are not patentably distinct from each other because the definition of X in the instant claim extensively overlap those in the above patent and also R1 to R11 definitions of the instant claims are similar to those claimed in the above patent. Thus one of ordinary skill in the art would be motivated to arrive at the claimed compounds using the above patent, because they are structurally so similar.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on (571)272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAIENDRA - KUMAR/
Primary Examiner, Art Unit 1621

S. Kumar
2/20/09